

## REMARKS

Please consider the foregoing amendments and the following remarks in response to the Office communication mailed on July 29, 2008.

The claims have been amended to require a conductive or antistatic substrate (see specification at p. 4, ln. 19-23) and a top coating comprising a polymer (see specification at p. 4, ln. 3-11) and particles with a conductive coating (see specification at p. 3, ln. 8-10) consisting essentially of ... substantially spherical glass particles with a conductive coating.... Claim 20 has been canceled.

Claims 12-13, 15-18, 20 and 23-25 have been rejected as being unpatentable over Hari et al. in view of Kojimoto under 35 U.S.C. §103(a).

Hari does not disclose or suggest a transparent top coating. Hari does not disclose or suggest incorporating substantially spherical glass particles in a top coating. And Hari does not disclose or suggest coating such particles with a conductive coating comprised of silver, aluminum, copper, nickel, gold, or an alloy thereof with another metal. Hari employs amorphous or spheroidal graphite and/or carbon fibers and/or finally divided metal. None of these materials are employed as particles in applicants' pending claims. Hari is not concerned about making a transparent top coating, a very important feature of applicants' invention because it allows the decorative substrate beneath the top coating to show through. Hari's invention is concerned only with conductivity and as such he uses conductive materials that are not employed by applicants. There is no disclosure in Hari that would teach or suggest to one skilled in the art that metal coated glass beads could be used to make a transparent conductive top coating for a conductive or antistatic flooring substrate.

Kojimoto requires a two component blend to make his electrically-conductive floor. One component comprises an electrically-conductive material of small short fibers and the other component comprises an electrically conductive filler comprised of a powdered or scaly electrically conductive material, including silver glass beads. Kojimoto's filler is employed in a range of from 10% to 50% but this amount is in addition to the conductive fibers. Thus, the total conductive material used by Kojimoto is greater than 10% and does not overlap with applicants' claimed range. Furthermore, Kojimoto teaches that a "large amount of electrically-conductive material" is necessary to make his invention effective and this teaches away from applicants' invention which requires a small amount, between 0.01 and 10% by weight of the top coating. (See Kojimoto translation, p.3, ln. 6-20.)

The combination of Hari with Kojimoto cannot render applicants' amended claims obvious because Hari's coating uses different conductive materials from applicants' and his coating is not transparent. Kojimoto requires a two component blend of conductive fibers and a conductive filler in amounts exceeding applicants' claimed range and teaches that large amounts of electrically-conductive material are essential. The combination cannot make or render obvious applicants' claimed invention and the rejection must be withdrawn.

Claim 19 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Hari in view of Kojimoto as applied above and further in view of either Glotfelter or Kim. Claim 19 depends from claim 16 and provides for a top coating thickness of between 0.5  $\mu\text{m}$  and 100  $\mu\text{m}$ . All of the limitations of dependent claim 16 and independent claim 12 from which claim 16 depends are incorporated in claim 19. Claim 19 accordingly

depends from claims which are patentably distinct from the primary references, Hari and Kojimoto, as discussed above. The disclosures of coating thicknesses provided by Glotfelter or Kim are not sufficient to overcome the deficiencies of Hari and Kojimoto. Withdrawal of the 35 U.S.C. §103(a) rejection of claim 19 is therefore respectfully requested.

Claims 21 and 26 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Hari in view of Kojimoto as applied above and further in view Wienand et al. Wienand is applied as teaching an antistatic or electrically conductive floor covering having a conductive top layer of a few tenths of a millimeter and for teaching a substrate of polyvinyl chloride resin (PVC) having vertical holes filled with conductive paste to produce vertical conductive channels. But the construction disclosed by Wienand is completely different from the construction claimed by applicants. Wienand fills holes in a substrate with a conductive paste and then coats one side of the substrate with the conductive paste. Alternatively, Weinand coats both sides of a substrate with conductive paste and then cuts the substrate along a plane parallel to the upper and lower surfaces. (See Fig. 5, line A-A and specification at col. 3., ln. 22-35.) In all embodiments of Weinand, the coated surface of the substrate is on the underside. The coated surface is not a top coating. Applicants employ glass spheres coated with a conductive layer and mix them with a dispersion of a topcoat material. Then this mixture is coated onto a substrate as a top coating. There is nothing about Wienand that would make applicants' product obvious because Weinand's construction is completely different from applicants' construction. Furthermore, the primary references in this rejection, Hari and Kojimoto, have been

distinguished above in respect of claim 12 from which claim 21 depends. Amended claim 26 is an independent claim but it incorporates all of the elements of claim 12 which have been distinguished from Hari and Kojimoto. Accordingly, claims 21 and 26 are allowable and withdrawal of the §103 rejection over Hari in view of Kojimoto and further in view of Wienand is respectfully requested.

### **Conclusion**

The instant application is believed to be in condition for allowance. A Notice of Allowance of claims 12, 15-19, 21 and 23-26 is respectfully requested. The Examiner is invited to telephone the undersigned at (908) 722-0700 if it is believed that further discussions, and/or additional amendment would help advance the prosecution of the instant application.

If any extension of time for this response is required, applicants request that this be considered a petition therefor. Please charge any required petition fee to Deposit Account No. 14-1263.

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Respectfully submitted,  
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